



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/7732,408	12/09/96	REINMULLER	J HUBR1099FFFFM

FELFE AND LYNCH
805 THIRD AVENUE
NEW YORK, NY 10022

QMQ31/0325

EXAMINER	
KOH, C	
ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 03/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/732,408

Applicant(s)

Reinmueller

Examiner

Choon P. Koh

Group Art Unit

3738

 Responsive to communication(s) filed on Jan 11, 1999. This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

 Claim(s) 1, 2, and 5-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

 Claim(s) _____ is/are allowed. Claim(s) 1, 2, and 5-22 is/are rejected. Claim(s) _____ is/are objected to. Claims _____ are subject to restriction or election requirement.

Application Papers

 See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on _____ is/are objected to by the Examiner. The proposed drawing correction, filed on _____ is approved disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

 Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

 Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3738

DETAILED ACTION

Response to Amendment

1. In view of Applicant's amendment, the rejection of claims 1-2, 5-22 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter is withdrawn.

Response to Arguments

2. Applicant's arguments filed on January 11, 1999 have been fully considered but they are not persuasive.

3. Claims 1,2,5,11-14 and 19-22 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Shane (U.S. Patent No. 5,358,521).

4. With respect to Shane's disclosure, Applicant argues that Shane's prosthesis essentially consists of a "fluid filled lumen" which contributes most of the bulk of the prosthesis which differs from Applicant's implant, because (a) a fluid filling is not used in the claimed invention and (b) the volume of the implant in the instant case is determined by the thin elements, not by a fluid, since the lubricant only fills the capillary gaps between the individual layers and makes only slight contribution to the filling volume.

Art Unit: 3738

5. However, this argument is based on unclaimed subject matter. As to the lack of fluid filling in the claimed invention, the term "comprising" in the claims does not exclude "a fluid filling" or a lumen, e.g. "a ballast lumen".

6. With respect to the volume of the implant, none of the claims recites the extent of contribution of "a plurality of thin pliable structural elements" to the volume of the implant. With respect to the thickness of the layers of pliable material, Applicant submits that "the maximum thickness of 0.2 mm appears to be impossible according to Shane because the layers are not allowed to fold, as this might cause the entire structure collapsing."

7. This argument is also based on unclaimed subject matter, because none of the claims recites that the layers of structural elements are "folded", and since the claims are directed to a range of thickness, i.e. 10-200 micrometer or 0.01-0.2 mm instead of specifically 0.2 mm, the argument is not commensurate in scope with the claimed invention.

8. Claims 6-10 and 15-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shane as applied to claim 1 above, and further in view of Wiese for the reasons set forth with respect to Shane.

Art Unit: 3738

9. Claim 18 is still rejected under 35 U.S.C. 103(a) as being unpatentable over Shane as applied to claim 1 above, and further in view of Scarborough for the reasons discussed regarding the primary reference of Shane.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ms. Choon P. Koh whose telephone number is (703) 305-1232. The examiner can normally be reached on Monday - Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 (formal) and (703) 308-2708 (informal).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Choon P. Koh
Choon P. Koh
March 22, 1999

Mickey Yu
Mickey Yu
Supervisory Patent Examiner
Group 3700